

REMARKS

This paper is a response to the non-final Office Action of September 19, 2008. Prior to the filing of this paper, Applicants filed a Notice of Appeal on March 18, 2009. With this paper, Applicants request prosecution be reopened. Prior to entry of this paper, claims 29-57 were pending in this application. Claims 29-57 are now amended; claims 58-82 are newly added; and no claims are canceled. Accordingly, upon entry of this paper, claims 29-82 will be pending. In addition, the specification is amended to correct a clerical error made in the Preliminary Amendment of February 2, 2004. No new matter is added.

In the Office Action mailed September 19, 2008, pending claims 29-57 were rejected. More specifically, the status of the application in light of this Office Action is as follows:

- (A) claims 29-57 were rejected under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter;
- (B) claims 29-57 were rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite; and
- (C) claims 29-57 were rejected under 35 U.S.C. § 103 as allegedly unpatentable over a combination of U.S. Patent No. 5,926,624 ("Katz") and U.S. Patent No. 5,790,664 ("Coley").

A. Response to Rejections under 35 U.S.C. § 101

Without conceding the merits of the 35 U.S.C. § 101 rejection, Applicants respectfully submit that this rejection is moot in light of the claim amendments made herein, e.g., because of the additional structural features now included in independent claims 29, 42, and 51. However, Applicants reserve the right to pursue claims in unamended or other form in this application or in continuing applications.

B. Response to Rejections under 35 U.S.C. § 112, second paragraph

Claims 29-57 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Specifically, pages 2-3 of the Office Action allege that these claims are "hybrid" claims and overlap two different statutory classes of inventions. MPEP § 2106 (IV) (B) is of relevance to this rejection and states (with added emphasis):

The scope of 35 U.S.C. 101 is the same regardless of the form or category of invention in which a particular claim is drafted. AT&T, 172 F.3d at 1357, 50 USPQ2d at 1451. See also *State Street*, 149 F.3d at 1375, 47 USPQ2d at 1602 wherein the Federal Circuit explained:

The question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to -- process, machine, manufacture, or composition of matter -- [provided the subject matter falls into at least one category of statutory subject matter] but rather on the essential characteristics of the subject matter, in particular, its practical utility.

For example, a claimed invention may be a combination of devices that appear to be directed to a machine and one or more steps of the functions performed by the machine. Such instances of mixed attributes, although potentially confusing as to which category of patentable subject matter the claim belongs, does not affect the analysis to be performed by USPTO personnel. Note that an apparatus claim with process steps is not classified as a "hybrid" claim; instead, it is simply an apparatus claim including functional limitations. See, e.g., *R.A.C.C. Indus. v. Stun-Tech, Inc.*, 178 F.3d 1309 (Fed. Cir. 1998) (unpublished).

This section of the MPEP makes clear that the rejections under 35 U.S.C. § 112, second paragraph are improper at least because claims 29-57 are apparatus claims having functional limitations.

Although Applicants do not concede the merits of the rejections under 35 U.S.C. § 112, Applicants' representative notes that he has recently taken over responsibility of this matter and has made the above amendments to improve the readability of claims 29-57. In light of these amendments, e.g., because of clarifications

of the functions of the various components and server computer systems of independent claims 29, 42, and 51, Applicants respectfully submit that the rejections under 35 U.S.C. § 112 are now moot. However, Applicants reserve the right to pursue claims in unamended or other form in this application or in continuing applications.

C. Response to Rejections under 35 U.S.C. § 103

Claims 29-57 were rejected under 35 U.S.C. § 103 as allegedly unpatentable over a combination of Katz and Coley. (See, pages 3-9 of the Office Action.)

Applicants respectfully submit that the rejection under 35 U.S.C. § 103 should be withdrawn at least because the Office Action fails to state a *prima facie* case of obviousness as required by MPEP § 2142. In order to establish a *prima facie* case of obviousness, the asserted combination of the applied references must teach or suggest *each and every claim feature*. See, *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The Board of Patent Appeal and Interferences ("BPAI") has also stated that a proper obviousness determination requires that an Examiner make "a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art." See, *In re Wada and Murphy*, Appeal 2007-3733, *citing In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis in original).

Further, the comparison of the claims features to the applied references must be supported with articulated reasoning to satisfy the initial burden of establishing a *prima facie* case of obviousness. For example, MPEP § 2142 states (with added emphasis):

"[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396. (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. **The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be**

some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

Also under MPEP § 2142, “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.” In the instant case, the Office Action has failed to make a comparison of all claimed features to the applied references and has also failed to articulate reasons and rational underpinnings for the 35 U.S.C. § 103 rejections. Instead, the Office Action makes vague, unsupported, and unexplained references to portions of the applied references as corresponding to features of the prior version of Applicants’ claims. In many cases, these references are to entire figures or to irrelevant portions of the applied references.

For example, in rejecting claim 29, page 3 of the Office Action pointed to the entirety of Figure 2 of Katz, without explanation, as corresponding to “a digital-content-accessing component invoked by a selection interface, provided by a digital-content supplier, to receive and authenticate one or more components of the digital content on a client computer[.]” Figure 2 of Katz shows blocks representing: (1) a mobile playback device; (2) a client computer system; (3) a distributable mass-storage medium; (4) a distribution network; and (5) a library server. Each of the blocks representing the mobile playback device, the client computer system, and the library server additionally include from 5 to 7 internal boxes representing internal components. Applicants’ representative simply has no idea of what in Figure 2 of Katz the Examiner relies upon as corresponding to the digital-content-accessing component and features thereof.

Likewise, page 3-4 of the Office Action pointed to the entirety of Figure 5 of Katz, without explanation, as corresponding to the feature “to store the one or more received and authenticated components in an unusable form on the client computer[.]” However, there is not a single teaching, suggestion, or mention in Figure 5 of Katz of

"authenticated components in an unusable form" or of anything stored or received on a client computer. Applicants' representative simply has no idea of what in Figure 5 of Katz the Examiner relies upon as corresponding to these features.

Further, page 4 of the Office Action points to lines 1-14 of column 8 of Katz, without explanation, as corresponding to "a license component incorporated within a component of the digital content that communicates with a remote licensing broker to verify that a user is licensed to receive the digital content[.]" However, this cited section of Katz discusses content stored on a Library Server. There is simply no teaching, mention, or suggestion of "a license component[.]" or communication "with a remote licensing broker to verify that a user is licensed to receive the digital content[.]" There is nothing even remotely suggestive of any of these features in the cited portion of Katz.

Finally, page 4 of the Office Action points to lines 41-48 of Coley, without explanation, as corresponding to "a license component incorporated within a component of the digital content that generates a useable form of the digital content from the one or more components of the digital content." However, this cited section of Coley discusses a license server, remote from a client computer that enables or disables a client application on a client computer. Nothing in this cited section discusses generating "a useable form of the digital content from the one or more components of the digital content" or "a license component incorporated within a component of the digital content[.]"

For at least the above discussed reasons, Applicants respectfully submit that the Office Action fails to state a *prima facie* case of obviousness with respect to independent claim 29. Accordingly, the rejections under 35 U.S.C. § 103 of independent claim 29 should be withdrawn.

In addition, Applicants also note that the Office Action fails to identify where the applied references disclose the features of "to receive and authenticate one or more

components of the digital content on a client computer" and "that generates a useable form of the digital content from the one or more components of the digital content[.]" Instead, the Office Action proposes that these features are "directed towards intended usage of the system." (Office Action, page 4). By failing to identify where the applied references disclose these features, the Office Action fails to comply with the above discussed BPAI requirement that the Office Action provide "a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art."

Although Applicants respectfully disagree with the position taken in the Office Action, independent claim 29 now specifically states that the "digital-content-accessing component ... is configured to ... download one or more components of the digital content; [and] authenticate the one or more components of the digital content" and the "license component that is incorporated ... is configured to ... communicate with a remote licensing broker to request a license certificate to the digital content." Accordingly, it is now exceedingly clear that these features are respective functions of the digital-content-accessing component and license component. Accordingly, Applicants respectfully request that these features be examined.

With respect to independent claims 42 and 51, page 4 of the Office Action states that they "are in parallel with claim 29 and are rejected for at least the same reasons." Although Applicants' disagree that independent claims 42 and 51 are "in parallel" with independent claim 29, the Office Action fails to state a *prima facie* case of obviousness in rejecting independent claim 29 and does not further support or explain the rejections of independent claims 42 and 51. Accordingly, Applicants respectfully submit that the Office Action also fails to state a *prima facie* case of obviousness with respect to independent claims 42 and 51. For at least these reasons, the rejections under 35 U.S.C. § 103 of independent claims 42 and 51 should be withdrawn.

The remaining dependent claims depend from one of independent claims 29, 42, or 51. Applicants respectfully submit that these dependent claims are allowable on at least this basis.

Applicants' representative notes that although Applicants' have amended various features of the claims, the substance of the claims is unchanged for purposes of the above discussion of the 35 U.S.C. § 103 rejections.

New Claims 58-82

Newly added claims 58-82 are patentable over the applied references for at least reasons similar to those discussed above with regard to independent claims 29, 42, and 51. Further, newly added claims 58-82 are fully supported by Applicants' disclosure, e.g., by figures 3, 4, and 8 and pages 6-7 and 13-17 of the as-filed disclosure.

Conclusion

In view of the foregoing, the pending claims comply with the requirements of 35 U.S.C. § 112 and 35 U.S.C. § 101, and are patentable over the applied art. Applicants accordingly request reconsideration of the application and a mailing of a Notice of Allowance. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to contact Davin Chin at (206) 359-8000.

Respectfully submitted,
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